

REMARKS

Claims 1-56 are pending in this application.

Applicants propose herein to amend claims 8, 13, 17-22, 28, 30-32, 34, and 54. The proposed changes to these claims would not introduce any new matter.

Applicants respectfully request reconsideration of the rejection of claims 1-15, 17, 19-21, 23, 27-35, and 52-56 under 35 U.S.C. § 102(e) as being anticipated by *Nakajima* (U.S. Patent No. US 6,650,437 B1). As will be explained below, the *Nakajima* reference does not disclose each and every feature specified in the claims, as proposed herein.

Applicants have carefully considered the Examiner's response to the arguments made in the Amendment filed on August 20, 2005 (and received in the PTO on August 24, 2005). In response to the Examiner's position that claim 1 does not require that the image generating apparatus and the image processing apparatus be separate entities, Applicants note that claim 1 includes elements written in means-plus-function format. An element written in mean-plus-function format "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, sixth paragraph. As such, claim 1 should be examined within the framework of the embodiments described in Applicants' specification. The embodiments described in Applicants' specification are implemented using an image generating apparatus that is separate from the image processing apparatus. Thus, the *Nakajima* reference does not disclose the structure described in Applicants' specification for performing the stated functions. Furthermore, the Examiner has not set forth any rationale demonstrating that the combination of the scanner and the exchanger disclosed in the *Nakajima* reference is the equivalent of the structure described in Applicants' specification for performing the stated functions. Accordingly, Applicants submit that the *Nakajima* reference does not support an anticipation rejection of claim 1, as properly construed under 35 U.S.C. § 112, sixth paragraph.

Regarding independent claims 6, 52, and 53, each of which includes elements written in means-plus-function format, Applicants submit that the arguments set forth above regarding claim 1 apply equally to claims 6, 52, and 53.

Regarding independent method claims 8 and 13, Applicants have proposed herein to amend these claims to define a method for generating either an image file (claim 8) or image data (claim 13) *in an image data generating apparatus*. As discussed above, the *Nakajima* reference does not disclose an image generating apparatus that is separate from the image processing apparatus. Consequently, the *Nakajima* reference does not disclose each and every feature of the methods defined in claims 8 and 13, as proposed herein.

Regarding independent claim 15, Applicants submit that the *Nakajima* reference does not disclose the claimed propagated data signal for at least the reason that the *Nakajima* reference does not disclose an image generating apparatus that is separate from the image processing apparatus.

Regarding independent claims 17, 28, 30, and 34, Applicants have proposed herein to amend these claims to specify an *independent* image processing apparatus. For at least the same reasons set forth above, Applicants submit that this change distinguishes the claimed subject matter from that shown in the *Nakajima* reference.

Regarding independent claims 54-56, Applicants note that independent claims 55 and 56 define image processing systems that include an image generating apparatus and an image processing apparatus, which has the specified features. As discussed above, the *Nakajima* reference does not disclose an image generating apparatus that is separate from the image processing apparatus as in the claimed subject matter. Regarding independent claim 54, Applicants have proposed herein to amend this method claim to clarify which method steps are implemented by an image generating apparatus and which method steps are implemented

by an image processing apparatus. Applicants submit that the proposed changes to claim 54 distinguish the claimed subject matter from that shown in the *Nakajima* reference.

Accordingly, for at least the foregoing reasons, independent claims 1, 6, 8, 13, 15, 17, 28, 30, 34, and 52-56, as proposed herein, are patentable under 35 U.S.C. § 102(e) over *Nakajima*. The dependent claims are likewise patentable under 35 U.S.C. § 102(e) over *Nakajima* for at least the same reasons set forth above regarding the applicable independent claim.

Applicants respectfully request reconsideration of the rejection of claims 36-39, 43-46, and 51 under 35 U.S.C. § 102(b) as being anticipated *Lathrop* (U.S. Patent No. 5,563,655). As will be explained in more detail below, the *Lathrop* reference does not disclose each and every feature specified in independent claims 36, 38, 43, and 45.

The *Lathrop* reference discloses the storing of a color conversion table in a PC memory card as the storage device for storing image data. In the digital storage device disclosed by *Lathrop*, the color conversion table is used to carry out prescribed color conversion suitable for target image data.

In the *Lathrop* reference, however, the image data does not relate one-to-one to the color conversion information. In particular, the color space information and its corresponding image data are not stored in the same image file. As a result, if, for example, the image data were copied into another memory, color conversion would not be expected to be carried out properly because the corresponding color conversion table remains in the PC card. On the other hand, the subject matter defined in independent claims 36 and 43 specifies that the color space information and the corresponding image data are stored in the image file. In this manner, the claimed subject matter avoids the above-noted color conversion problem to which *Lathrop* is susceptible. Thus, for at least the reason that the *Lathrop* reference does not

disclose the features that relate image data one-to-one to color conversion information, the *Lathrop* reference does not disclose each and every feature specified in claims 36 and 43.

Regarding independent claim 38, Applicants note that this claim includes elements written in means-plus-function format. In support of the anticipation rejection, the Examiner has not set forth any rationale that demonstrates that claim 38 has been interpreted in accordance with 35 U.S.C. § 112, sixth paragraph. As such, Applicants respectfully submit that the Examiner has not established that the *Lathrop* reference raises a *prima facie* case of anticipation against claim 38.

Regarding independent claim 45, as discussed above, the *Lathrop* reference does not disclose the storing of color space information and its corresponding image data in the same image file. Thus, for at least this reason, the *Lathrop* reference does not disclose each and every feature of the image processing apparatus defined in claim 45.

Accordingly, for at least the foregoing reasons, independent claims 36, 38, 43, and 45 are patentable under 35 U.S.C. § 102(b) over *Lathrop*. The dependent claims are likewise patentable under 35 U.S.C. § 102(b) over *Lathrop* for at least the same reasons set forth above regarding the applicable independent claim.

Applicants respectfully request reconsideration of the rejection of claims 40-42 and 47-50 under 35 U.S.C. § 103(a) as being unpatentable over *Lathrop* in view of *Buhr et al.* (U.S. Patent No. 5,528,339). The deficiencies of the *Lathrop* reference relative to the claimed subject matter specified in independent claims 38 and 45 are set forth above in connection with the anticipation rejection based on the *Lathrop* reference. The *Buhr et al.* reference does not cure the above-discussed deficiencies of the *Lathrop* reference relative to the claimed subject matter. Accordingly, claims 40-42 and 47-50 are patentable under 35 U.S.C. § 103(a) over the combination of *Lathrop* in view of *Buhr et al.* for at least the same reasons set forth above.

Applicants respectfully request reconsideration of the rejection of claims 16, 24, and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Nakajima* in view of *Parulski et al.* (U.S. Patent No. US 6,310,647 B1). The deficiencies of the *Nakajima* reference relative to the claimed subject matter are set forth above in connection with the anticipation rejection based on the *Nakajima* reference. The *Parulski et al.* reference does not cure the above-discussed deficiencies of the *Nakajima* reference relative to the claimed subject matter. Accordingly, claims 16, 24, and 25 are patentable under 35 U.S.C. § 103(a) over the combination of *Nakajima* in view of *Parulski et al.* for at least the same reasons set forth above.

Applicants respectfully request that the amendments proposed herein be entered. The proposed amendments respond to the Examiner's position that Applicants' arguments do not coincide with the claim language, and could not have been presented earlier because the Examiner's position was raised for the first time in the Final Office Action. Moreover, the proposed amendments do not raise any new issues or require any additional search. Accordingly, Applicants respectfully submit that the proposed amendments comply with the requirements of 37 C.F.R. § 1.116(b) and should be entered.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-56, as proposed herein, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in

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connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP006).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read 'P. B. Martine', with a long horizontal line extending to the right.

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